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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/204,390	12/02/98	EVERLING	D P/2167-61

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NEW YORK NY 10036-8403

EXAMINER

TEITELBAUM, A

ART UNIT	PAPER NUMBER
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2765

DATE MAILED: 07/17/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/204,390

Applicant(s)

EVERLING ET AL.

Examiner

Anne H Teitelbaum

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☒ Responsive to communication(s) filed on 5/8/2000.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) _____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

1. This communication is in response to the amendment filed on 5/8/2000.
2. Examiner acknowledges applicant's changes to the specification and withdraws previous objection.
3. Examiner acknowledges applicant's changes to the abstract and withdraws previous objection.
4. Examiner acknowledges applicant's changes to the drawings and withdraws previous objection.
5. Examiner acknowledges applicant's intent to file a new oath with the appropriate corrections.

Response to Arguments

6. Applicant's arguments filed 5/8/200 have been fully considered but they are not persuasive.
7. Applicant argues that Lawlor does not anticipate the "receiving of transaction data, the transaction data containing account numbers". However, Lawlor clearly defines transaction data and specifically account numbers as a type of transaction data.

"To use billpaying features, customers provide the service provider in advance with a list of payees (names, account numbers, addresses)." (col. 10, lines 50-54)

"The authorization module 80D is the means by which the system determines the customer identity (through the PIN and other values transmitted by the terminal). User account number and PIN values are transmitted to the user's bank (over the ATM network 66 in the preferred embodiment) for verification. When the authorization module 80D receives verification from the bank the user is cleared for transactions." (col. 19, line 63 to col. 20, lines 3)

"For example, a user having a bank account in bank A (the "on us" bank) connected to the Internet ATM network may use the ATM machine of bank B (a "foreign" bank) to withdraw from his bank A account. The mainframe computer of bank B generates, in response to the user's request via the ATM message specifying the user's PIN (personal identification number), the user's account number the user's bank and the amount to be withdrawn. This ATM withdrawal message is then sent over the ATM network and is received by the computer of bank A. Bank A checks the message for validity (i.e., to make sure the PIN is correct), determines whether the user has a sufficient account balance to honor the withdrawal request (the message processing thus provide an automatic account balance check), and then processes the request by posting a debit memo against the user's bank account (the bank A computer does not actually withdraw funds from the user's account at this time, but will process the memo during the posting and settlement process later that day). The bank A computer then sends a confirmation message back over the ATM network to the bank B computer confirming that the user's account has been debited and that at clearing time bank A will pay the funds to bank B. Based on receipt of the confirmation message over the ATM network, the bank B computer controls the bank B ATM machine to dispense the requested funds to the ATM user.

An ATM "account inquiry" message also exists to permit the user to determine the balance of his bank account(s). Similarly, an ATM "account transfer" message allows a user to transfer funds from one account to another in the same bank (but typically does not permit the user to transfer funds between banks). " (col. 20, line 52 to col. 21, line 15)

Therefore, Lawlor's invention clearly reads on applicant's claims and the rejection remains.

Applicant argues that Lawlor does not "identify non-issuer account numbers that represent accounts that are not issued by an issuer". Examiner points out that ATMs have the same functionality in identifying an account number and an account number of a different bank, which is the non-issuing institution. Applicant's claims are not directed towards an ATM, however they do not exclude ATMs and therefore the rejection remains.

Applicant argues that Lawlor does not teach the "matching of the identified non-issuer account numbers with account numbers that represent accounts issued by the issuer". Figure 1 of Lawlor clearly shows a database, which inherently has these capabilities. Once again, Lawlor clearly identifies that there are both issuer account numbers and non-issuer account numbers in his system. The inclusion of a database in Lawlor's invention clearly teaches the matching capabilities in applicant's claims and therefore the rejection remains.

Since Lawlor does in fact read on applicant's claim 1, it remains rejected, and therefore dependent claims 2-8 also remain rejected under 35 U.S.C. 102(e) as being anticipated by Lawlor et al (U.S. Patent No. 5,870,724).

Applicant claims that Pascoe does not teach "identification of which data is unnecessary and which data is redundant" and "specifically which type of data to eliminate from the data". However, claim 9 does not state anywhere that the invention needs to identify which data is unnecessary and which data is redundant. Examiner agrees that Pascoe does not specifically use the words "transaction data" or "account numbers". However, Pascoe does *clearly* state that it "allows a user to select and *specify criteria* for "scrubbing" a file or container object". Since Pascoe allows the option to designate which files to "scrub" it is obvious when combined with Lawlor that the criteria that will be chosen can include transaction data such as account numbers. Since the combination of Pascoe and Lawlor *clearly* anticipate scrubbing the files to delete the redundant transaction data, claim 9 remains rejected under 35 U.S.C. 103(a)

as being unpatentable over Lawlor et al (U.S. Patent No. 5,870,724) in view of Pascoe (U.S. Patent No. 5,813,015).

Applicant argues that for claim 10, Konya does not teach "associating non-issuer account numbers and issuer account numbers". However, Examiner once again refers to the argument for claim 1 by Lawlor. Since Konya discloses that the "main computer includes a database containing entry codes and routing codes for a plurality of banks belonging to the present electronic transfer network" (abstract) it clearly reads on associating account numbers since matching information is inherent in a database.

Examiner once again refers to the above reasoning for Pascoe's description of scrubbing files, making it relevant to this case. Therefore, the combination of Pascoe and Konya do in fact teach the limitations of claim 10 that include not only associating account numbers but scrubbing the files. Since applicant's claim 10 does not signify that it is *not* an ATM machine, Konya's invention is applicable because it provides the same functionality with account numbers.

Applicant has given no support to their argument against examiners official notice and therefore, the rejection remains based on the official notice taken. For further explanation, generating a new list from an original list is also a function of a database, which has been clearly shown to be in the system.

Applicant argues for claim 10 that Pascoe does not teach "identifying account numbers in the list which represent accounts owned by the customers." However, applicant admits that Pascoe does teach searching methods. When this identification method is combined with Konya's invention involving different accounts, it reads on

applicant's claim 10 because searching or identifying methods are clearly a significant aspect of a transaction data system and would help the efficiency of the system.

Since Konya and Pascoe do read on applicant's claim 10, it remains rejected under 35 U.S.C. 103(a) as being unpatentable over Konya (U.S. Patent No. 5,937,396) in view of Pascoe (U.S. Patent No. 5,813,015).

Konya and Pascoe, in addition to Lawlor are in the same financial business art and are therefore relevant applicable art.

Claims 11-21 also remain rejected since applicant's arguments for the claims they are dependent upon are moot.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne H Teitelbaum whose telephone number is 703-306-5679. The examiner can normally be reached on Monday-Thursday 7:30am-5:00pm and alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tod Swann can be reached on (703) 308-7791. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-9051 for regular communications and 703-308-5337 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

aht
July 13, 2000



ERIC W. STAMBER
PRIMARY EXAMINER